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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,650	06/27/2003	Darrell A. Gauthier	4275-007 (0007.6)	7001
26158	7590	10/06/2005	EXAMINER	
WOMBLE CARLYLE SANDRIDGE & RICE, PLLC			LYLES IRVING, CARMEN V	
P.O. BOX 7037			ART UNIT	
ATLANTA, GA 30357-0037			PAPER NUMBER	
			1731	

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/608,650

**Applicant(s)**

GAUTHIER, DARRELL A.

**Examiner**

Carmen Lyles-Irving

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2003 and 15 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 26-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/19/2003</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5, 6, 9, 13, 16, 18, 20, 22 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated over Bromberg (U.S. Patent No. 3,219,041). Regarding claim 1, Bromberg '041 teaches a capsule for use as a filter, i.e. an insert, for a smoking article comprising an outer shell that defines a cavity (Figure 1); a plurality of perforations through at least a portion of the outer shell; a filter media substantially filling the cavity (column 2, lines 66-68); wherein the outer shell is configured to be received within the smoking article (Figure 1) and the insert is placed within the smoking article at a point between the tobacco and the first end (Figure 1). Accordingly, claims 1 and 13 are rejected.

Regarding claims 2 and 20, Bromberg '041 teaches the outer shell of the capsule is composed of gelatin (column 2, line 35-39). Accordingly, claims 2 and 20 are rejected.

Regarding claim 5, Bromberg '041 teaches the media is a flavor-modifier or aroma-modifier (column 2, lines 49-51). Accordingly, claim 5 is rejected.

Regarding claim 6, Bromberg '041 teaches the outer shell of the capsule having an oblong shape (Figure 3). Accordingly, claim 6 is rejected.

Regarding claim 9, Bromberg '041 teaches the outer shell of the capsule has a circular cross-section (Figure 3). Accordingly, claim 9 is rejected.

Regarding claim 16, Bromberg '041 teaches the media is flavor-modifying media (column 2, lines 49-51). Accordingly, claim 16 is rejected.

Regarding claim 18, Bromberg '041 teaches the media is aromatic-modifying media (column 2, lines 49-51). Accordingly, claim 18 is rejected.

Regarding claim 22, Bromberg '041 teaches the smoking article is a cigarette (column 1, lines 12-15). Accordingly, claim 20 is rejected.

Regarding claim 24, Bromberg '041 teaches a cigarette comprising a tobacco charge, and a filter, the filter further comprising: (i) an outer shell that defines a cavity (column 2, lines 35-39); (ii) a plurality of perforations through the outer shell (column 2, lines 42-45); and (iii) a tobacco-smoke filtering media, i.e. flavor-modifier, substantially filling the cavity (Figure 3), wherein the filter is placed at an effective location to the tobacco charge for the filtration of the tobacco smoke through the media (Figure 1). Accordingly, claim 24 is rejected.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bromberg '041, as applied to claim 1 above, and further in view of Jones (U.S. PG Pub

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2002/0187185). Bromberg '041 teaches the outer shell of the capsule is made of gelatin (column 2, lines 35-39). Bromberg '041 fails to teach that the capsule is composed of hydroxypropyl methylcellulose. However, Jones teaches that hydroxypropyl methylcellulose is a replacement for gelatin. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Bromberg '041 with the teachings of Jones to produce a capsule for use a filter for a smoking article out of hydroxypropyl methylcellulose as it has been shown that hard capsules have been produced from hydroxypropyl methylcellulose successfully.

Accordingly, claim 2 is rejected.

Claims 3, 7-8, 10-12, 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bromberg '041, as applied to claim 1 above. Regarding claims 3 and 21, Bromberg '041 teaches the perforations are confined to the central portion of the rearward end so that no tar or other products which may be freed from the tobacco and collect in the capsule to flow through the perforations and reach the lips of the smoker (column 2, line 69 – column 3, line 2). Bromberg '041 fails to teach that the perforations are individually of such a diameter that a substantial portion of the filter media cannot readily pass therethrough. However, it would have been obvious to one of ordinary skill in the art at the time of the invention for the perforations to be individually of such a diameter that a substantial portion of the filter media cannot readily pass therethrough because as it is undesirable for tar and other products to reach the mouth of the user. Accordingly, claims 3 and 21 are rejected.

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Regarding claim 7, due to a lack of criticality and unexpected results, it would have been obvious to one of ordinary skill in the art to use an oblong outer shell with a diameter, i.e. approximately 8 mm, and a length, i.e. between about 3 mm and about 12 mm, necessary to produce a cigarette able to achieve the desired end result.

Accordingly, claim 7 is rejected.

Regarding claim 8, due to a lack of criticality and unexpected results, it would have been obvious to one of ordinary skill in the art for the capsule to be an oblong outer shell with carbon of an amount (about 200 mg to about 300 mg) sufficient to filter the cigarette smoke. Accordingly, claim 8 is rejected.

Regarding claims 11, due to a lack of criticality and unexpected results, it would have been obvious to one of ordinary skill in the art at the time of the invention for the perforations to be of a diameter of a diameter of such a diameter that a substantial portion of the filter media cannot readily pass therethrough. Accordingly, claim 11 is rejected.

Regarding claim 12, due to a lack of criticality and unexpected results, it would have been obvious to one of ordinary skill in the art at the time of the invention for the capsule to include ends having end surface areas, and perforations comprising approximately 45 percent of the end surface areas of the capsule as a matter of design choice. Accordingly, claim 12 is rejected.

Regarding claim 23, Bromberg '041 fails to teach that the cigarette further comprises a mouthpiece having a filter and a tobacco charge, whereby the insert is placed between the tobacco charge and the mouthpiece filter. However, due to a lack

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of criticality and unexpected results, it would have been obvious to locate the insert in a location within the filter to achieve the maximum filtration of the tobacco smoke.

Furthermore, the location of the capsule is a matter of design choice. Accordingly, claim 23 is rejected.

Claims 4, 5, 14, 15, 17, 19 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bromberg '041, as applied to claim 1 above, in view of Wartman, Jr. (U.S. Patent No. 3,550,508). Regarding claims 4 and 15, Bromberg '041 fails to teach the media is carbon. However, Wartman teaches the media is carbon (column 2, lines 67-71). It would have been obvious to one of ordinary skill in the art at the time of the invention for the filtering media to be carbon, as activated carbon is known to have a beneficial effect on tobacco smoke passed in contact with it. Accordingly, claim 4 is rejected.

Regarding claims 16, Wartman, Jr. teaches the filtering media is a flavor modifier or an aroma-modifier (column 2, lines 56-64). Accordingly, claims 5 and 16 are rejected.

Regarding claim 14, Wartman, Jr. teaches the media is tobacco smoke-filtering media (column 2, lines 67-71). Accordingly, claim 14 is rejected.

Regarding claim 17, Wartman, Jr. teaches that the flavor-modifying media is menthol (column 2, lines 60-64). Accordingly, claim 17 is rejected.

Regarding claim 19, Wartman, Jr. teaches the media is a combination of tobacco smoke-filtering and flavor-modifying media (column 57-67). Accordingly, claim 19 is rejected.



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Regarding claim 25; Wartman, Jr. teaches the filter media can be activated carbon (column 2, lines 64-67). Bromberg '041 teaches that filter media such as activated carbon (charcoal) is capable of filtering undesired components such as tars and nicotine (column 2, lines 20-24 and lines 28-31). Accordingly, claim 25 is rejected.

Claims 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bromberg '041, as applied to claim 1 above, in view of Chapman et al (U.S. Patent No. 5,690,127). Bromberg '041 fails to teach the capsule has a diameter of approximately 8 mm. However, Chapman teaches that conventional cigarettes comprise a cylindrical tobacco rod that is between 7.0 and 10.0 mm in diameter and 60 mm and 125 mm in length (Figure 1; column 1, lines 15-17). It would have been obvious to one of ordinary skill in the art at the time of the invention to use a capsule with a diameter, i.e. approximately 8 mm, capable of fitting into the confines of the cigarette wrapper. Accordingly, claim 10 is rejected.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bromberg (U.S. Patent No. 3,173,451); Homburger (U.S. Patent No. 3,297,038); Tateno (U.S. Patent No. 4,889,144); and Yamamoto et al (U.S. Patent No. 5,264,223).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carmen Lyles-Irving whose telephone number is (571) 272-2945. The examiner can normally be reached Monday through Friday from 8am-5pm.

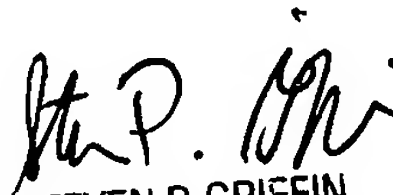


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CLI  
10/01/2005

  
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